REMARKS

In response to the final Office Action dated September 9, 2005, Applicant respectfully requests favorable reconsideration of the above-captioned application in view of the following remarks. Claims 1-55 remain pending in this application.

Record of Interview

At the outset, the undersigned thanks the Examiner for the courtesies extended during the telephone discussion on November 28, 2005. The Examiner contacted the undersigned at the request of the undersigned.

In the discussion, the undersigned summarized certain points made in the written arguments which follow. The Examiner suggested that the undersigned submit the written arguments to the Patent Office to allow the Examiner to more formally address the arguments. No agreement was reached during the discussion.

Request to Remove the Finality of the Outstanding Office Action

This Office Action has been made final, even though the Patent Office has applied a new reference, U.S. Patent No. 6,189,146 to Misra et al. (referred to below as simply "Misra"), to claims that have not been amended. The Office Action justifies making the Office Action final on the grounds that Misra was identified in an Information Disclosure Statement (IDS) filed after receiving a first Office Action (on June 22, 2205), which required the payment of a $180 fee. The Patent Office cites MPEP § 609 as providing authorization for its position. However, as early as June 15, 2001, **the Applicant prominently brought the Patent Office's attention to the existence of the Misra patent application on page 1 of the instant application**, under the heading "RELATED APPLICATIONS." With respect to the Misra patent application, the June 22, 2005 IDS

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merely updates the information provided on page 1 of the application, e.g., by providing the patent number assigned to the issued Misra patent.

In view of the fact that the Examiner was duly notified of the existence of the Misra patent application prior to issuing the first Office Action, the finality of the present Office Action is not appropriate. The Applicant respectfully requests that the final status of the present application be withdrawn, and Applicant notified of same.

Request to Withdraw the 35 U.S.C. § 102 and § 103 Rejections

Claims 1-4, 10-12, 14-21, 26-30, 32-37, 41-47, and 49-55 are rejected under 35 U.S.C. § 102(b) as being anticipated by Misra. Applicant respectfully traverses this rejection for the following reasons.

Prior to addressing the rejection, it is believed that the Patent Office may again benefit from a brief review of exemplary aspects of the subject matter disclosed in the specification. The detailed description in the specification does not limit the claims. Nevertheless, an understanding of certain salient features of the subject matter described in the specification will help the Patent Office better appreciate the distinction between the claims (to be discussed below) and the Misra reference.

One aspect of the subject matter described in the specification pertains to issuance of a pool of available licenses to clients in an efficient manner. More specifically, one problem encountered in the art is that licenses installed on client computers become "lost." This happens, for example, when the client computers are reconfigured. The effect of losing licenses is that the clients cannot make efficient use of licenses. For example, through the loss of licenses, the clients may exhaust an available supply of licenses, requiring that the clients purchase more licenses, even though the lost licenses remain valid.

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The specification describes a solution to this problem "through leasing licenses to clients and continually expiring and re-leasing them in a way that nets out the overall distribution of purchased licenses" (page 10, lines 18 and 19). Namely, in one implementation, the invention expires licenses when the clients do not take actions which cause the licenses to be updated and reissued within a specified period of time, thus adopting a "use it or lose it" approach to license management. The expired licenses go back into an available pool of licenses for other clients to use, thus reducing the inefficiencies discussed above, e.g., where "lost" licenses remain valid but cannot be used.

Misra, in part, also identifies a strategy for addressing the problem of lost licenses. Consider the following exemplary passages of Misra that have a bearing on Misra's technique for addressing the problem of lost licenses:

> When a license is requested, the license server initially checks if the requesting client has already been issued a license. When this situation is detected, the license server issues the *existing* license to the client. This is actually reissuing of the *same license* that was previously issued. This allows the client to gracefully recover licenses when they are lost. (column 3, lines 1-7, emphasis added)
>
>
>
> When a client 30 connects to the intermediate server 32, it must present a valid license. If the client does not have an appropriate license, the intermediate server 32 assists the client in obtaining a license from the license server 28. This provides an automated mechanism for distributing licenses to clients. The license server 28 initially checks if the requesting client already has been issued a license. When this situation is detected, the

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license server 28 issues the *existing license* to the client. This allows the client to gracefully recover licenses when they are lost. (column 4, lines 49-58, emphasis added)

.

The license cache 136 is kept in persistent (non-volatile) storage. Clients that do not have persistent storage can be issued licenses as long as they can generate a unique client ID and can respond to the client platform challenge protocol. The licensing system handles this case in the same way it recovers lost licenses. On connect, the intermediate server contacts the license server for a new license. The license server realizes, through the system ID, that the license has already been issued. In this case, the *old license* is simply returned to the client. Clients that cannot generate a system ID or respond to the platform challenge protocol use the legacy licenses stored in the legacy license store 130 at the intermediate server 32. (column 12, lines 15-27, emphasis added)

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At step 200 in FIG. 6, the license server determines whether the response is proper, and hence, whether the client is authentic. If the client is authenticated (i.e., the "yes" branch from step 200), the license server proceeds with granting a software license. The license server 28 first queries the secure license store 112 to ii determine if a license for that client has already been issued (step 202). This procedure accommodates the case in which the client has lost its valid software license. If a non-expired license is found, the license server 28 forwards it to the client 30. (column 15, lines 9-18)

In brief, the above-cited passages of Misra describes in part a way for a client to obtain its old license in the event that the old license is lost (e.g., Misra states that the "old license is simply returned to the client" (column 12, lines 23-24)). This does not pertain to the technique described in the instant specification of purposely expiring a

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license under a "use it or lose it" policy, and, if the license becomes expired, allowing another client to potentially use this license.

Indeed, consider the following additional passage of Misra:

> To prevent the software license from being copied from one client machine to another, the *software license is assigned to the specific client* by including its client ID within the license. The software license also has a corresponding *license ID that is associated with the client ID* in the client assignment table 116 in the secure license store 112 at the license server. The contents of the license are described above in Table 5. (column 15, lines 29-36, emphasis added)

The fact that a license ID is associated with a client ID suggests that the above-cited passage of Misra does not contemplate that a license is freed up if not used by one client prior to the license's expiration date, and then potentially used by another client.

Now turning to the claims, there are nine independent claims rejected under Section 102, namely, claims 1, 2, 12, 16, 19, 30, 35, 41 and 43. Each of these claims recite one or more elements that the above-cited passages of Misra do not disclose. Each independent claim will be addressed in turn as follows.

Claim 1 is reproduced below with emphasis:

> 1. A method of managing a software license, comprising:
>
> issuing a license to a client, the license having an expiration date;
>
> receiving a license request from the client *during a license update period*;
>
> in response to the license request, providing *a new expiration date for the license*; and

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reissuing the license *with the new expiration date* to the client.

The above-cited passages of Misra at least do not disclose "receiving a license request from the client during a license update period," "in response to the license request, providing a new expiration date for the license," and "reissuing the license with the new expiration date to the client," within the context of the claim read as a whole. First, for instance, the above-cited passages of *Misra do not disclose the concept of a "license update period."* This is consistent with the above discussion, since the above-cited passages of Misra do not describe a technique of expiring a license if it is not used, and potentially reassigning the expired license to another client. Second, the above-cited passages of Misra do not disclose reissuing a license with a "new expiration date" to the client. On the contrary, the above-cited passages indicate that, when Misra reissues a license, Misra issues the "same license" (also referred in Misra as the "old license"). The above-cited passages indicate that *Misra's old license would have the same (or old) expiration date, not a new expiration date as being claimed.* This is made clear where Misra states, in column 15, lines 13-18, that a lost license is forwarded to the client only if it is "non-expired," meaning that the license will include the same expiration date as the old expiration date, not a new expiration date.

In addressing the issue of expiration date, the Office Action states in paragraph No. 7:

> Although Misra does not explicitly state a new expiration date a this [sic] is implied as all the licensees issued have an expiration date, if you issuing [sic] a client a new license it is inherent that you are putting a new expiration date with that license.

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However, the Examiner cannot interpret an old expiration date as a new expiration date as this goes against the plain meaning of these words in ordinary usage. For example, suppose that the undersigned requested that the Examiner send another copy of the outstanding Office Action, because, let us say, that the Office Action was lost in the mail. According to the plain meaning of words, the Examiner may choose to send this Office Action with either the old expiration date or a new expiration date (where the "expiration date" would correspond to the period for reply to the Office Action). Here, according to the plain meaning of the words, it would be implicitly and naturally assumed that an old expiration date would be the *same expiration date* as the original Office Action, while a new expiration date would be a *different expiration date* compared to the original Office Action.

Claim 2 is reproduced below with emphasis:

> 2. A method of managing a software license, comprising:
>
> issuing a license to a client, the license having an expiration date;
>
> receiving a license request from the client *during a license update period*;
>
> determining that the client has lost the license;
>
> issuing a new license to the client if a new license is available, *the new license having a new expiration date*; and
>
> issuing a temporary license to the client if a new license is not available, the temporary license being valid for a temporary period.

The above-cited passages of Misra at least do not disclose "receiving a license request from the client during a license update period," and "issuing a new license to the client if a new license is available, the new license having a new expiration date," within

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the context of the claim read as a whole. As stated above above, the above-cited passages indicate that Misra's processing does not involve the concept of an update period. Further, in the event that a license is lost, the above-cited passages indicate that Misra does not disclose issuing a new license having a *new* expiration date. When a license is lost, the above-cited passages indicate that Misra provides the same (old) license to the client with the same (old, not new) expiration date.

It is noted that Misra also provides a technique for providing an upgraded license (note column 16, line 38 to column 17, line 7). However, this passage of Misra does not disclose that the update procedure involves receiving requests in an "update period" as claimed. The above-cited passage of Misra also does not disclose that the upgraded license has a new expiration date.

As to the upgrade feature, paragraph No. 8 of the Office Action points to column 16, lines 59-63 of Misra, which recites, in part, "The license server 28 validates the old license and extracts the license's ID, which is used as an index into the client assignment table 116 in the secure license store 112. The license server 28 examines the table 116 to determine whether an upgrade is available (step 246)." From this passage, the Office Action draws the conclusion that upgrade is "only available during a certain period time," from which the Office Action presumable draws the ultimate conclusion that Misra discloses a license update period.

However, the mere existence of an upgraded license does not define an update period in the context of claim 2. For instance, claim 2 goes on to recite "issuing a new license to the client if a new license is available." If the update period is defined as a period in which a new license is merely available, then this interpretation would render the "issuing" element of claim 2 superfluous. Since this interpretation of the claim is inherently inconsistent, it is not a viable interpretation of the claim.

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Claim 12 is reproduced below with emphasis:

12. A method of managing a software license, comprising:

receiving a license request from a client;

determining that the expiration date of a license previously issued to the client has been reached;

reissuing the license to the client if the license is available, *the reissued license having a new expiration date*;

issuing a new license to the client if a new license is available and the previously issued license is not available, the new license having a new expiration date; and

denying the client access to software resources if the previously issued license is not reissued and a new license is not issued.

The above-cited passages of Misra at least do not disclose, in the event that an expiration date of a license has been reached, "reissuing the license to the client if the license is available, the reissued license having a new expiration date," within the context of the claim read as a whole. In contrast, Misra discloses "In the event that the client 30 does not submit a valid license or submits an expired license, the intermediate server requests a new software license from the license server (step 188 in FIG. 5)" (column 14, lines 49-52). Thus, according to this passage, when a license has expired, Misra does not attempt to find the same license, it grants a new license.

Claim 16 is reproduced below with emphasis:

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16. A method, comprising:

receiving a license to access software resources, the license having an expiration date;

requesting a license update *during an update period preceding the expiration date*; and

in response to the requesting, *receiving the license as a reissued license during the update period, the reissued license having a new expiration date.*

The above-cited passages of Misra at least do not disclose "requesting a license update during an update period preceding the expiration date," and "in response to the requesting, receiving the license as a reissued license during the update period, the reissued license having a new expiration date," within the context of the claim read as a whole. As set forth above, the above-cited passages of Misra do not disclose the concept of an update period. Further, the above-cited passages of Misra do not disclose reissuing a license with a *new* expiration date.

Claim 19 is reproduced below with emphasis:

19. A method, comprising:

receiving a license to access software resources, the license having an expiration date;

having lost the license, requesting a license update *during a license update period*;

receiving a new license if a new license is available, the new license having a new expiration date; and

receiving a temporary license if a new license is not available, the temporary license being valid for a temporary period.

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Among other deficiencies, the above-cited passages of Misra do not disclose "having lost the license, requesting a license update during a license update period, and "receiving a new license if a new license is available, the new license having a new expiration date," within the context of the claim read as a whole. To repeat, the above-cited passages of Misra do not disclose the concept of an update period. Further, if a license has been lost, the above-cited passages indicate that Misra provides the same (old) license, not a new license with a new expiration date as claimed.

Claim 30 is reproduced below with emphasis:

> 30. A method comprising:
>
> receiving a license to access software resources, the license having an expiration date;
>
> making a license request after the expiration date has been reached;
>
> *receiving the license as a reissued license if the license is available, the reissued license having a new expiration date;*
>
> receiving a new license if a new license is available and the license is not available, the new license having a new expiration date; and
>
> being denied access to the software resources if a reissued license or a new license is not received as a result of the license request.

The above-cited passages of Misra at least do not disclose, after making a license request after the expiration date has been reached, "receiving the license as a reissued license if the license is available, the reissued license having a new expiration date," within the context of the claim read as a whole. As stated in column 14, lines 49-52,

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Misra grants a new license when a client makes request after the expiration date of the license; the above-cited passages of Misra do not contemplate providing the same license as a reissued license.

Claim 35 is reproduced below with emphasis:

> 35. A license server comprising:
>
> an available license pool to store licenses;
>
> an assigned license pool to store information regarding licenses assigned to clients;
>
> a request handling module to receive a license request;
>
> a new license module to search the available license pool, setting an expiration date on a new license if a new license is available, and issuing the new license to a client; and
>
> *a license clean-up module operating periodically to review the assigned license pool and return any license to the available license pool which is found to have reached its expiration date.*

The above-cited passages of Misra at least do not disclose, "a license clean-up module operating periodically to review the assigned license pool and return any license to the available license pool which is found to have reached its expiration date," within the context of the claim read as a whole. As disclosed in column 15, lines 29-36, Misra grants licenses to clients on a one-to-one basis. As such, the above-cited passages of Misra do not contemplate returning expired licenses to an available license pool.

Claim 41 is reproduced below with emphasis:

> 41. A terminal server, comprising:
>
> a database to provide terminal server resources to a client;

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a client access module executing on the one or more processors for allowing access to the terminal server resources by a client having a license and denying access to the terminal server resources by a client not having a license; and,

a license request module to:

obtain a license for an unlicensed client that connects to the terminal server;

obtain a license update for a licensed client that connects to the terminal server during a license update period; and

obtain a license update or a new license for a previously licensed client connecting to the terminal server after the license update period.

The above-cited passages of Misra at least do not disclose a license request module configured to "obtain a license update for a licensed client that connects to the terminal server during a license update period," and "obtain a license update or a new license for a previously licensed client connecting to the terminal server after the license update period," within the context of the claim read as a whole. For instance, as noted above, the above-cited passages of Misra do not disclose the concept of an update period.

Finally, claim 43 is reproduced below with emphasis:

43. A system for licensing software, comprising:

a license generator configured to receive a license purchase request, and to produce and transport licenses in response to the license purchase request; and,

a license server configured to submit the license purchase request to the license generator and store the licenses received in response to the license purchase request in an available license pool;

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the license server further configured to issue individual licenses to individual clients from the available license pool, the individual licenses each having an expiration date;

the license server further configured to return licenses that reach their expiration date to the available license pool.

The above-cited passages of Misra at least do not disclose the claims elements that recite, "the license server further configured to issue individual licenses to individual clients from the available license pool, the individual licenses each having an expiration date," and "the license server further configured to return licenses that reach their expiration date to the available license pool," within the context of the claim read as a whole. For instance, the above-cited passages of Misra do not disclose returning expired licenses to an available license pool.

As stated in MPEP § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As noted above, the above-cited passages of Misra fail to disclose multiple elements in the independent claims. Accordingly, these passages do not anticipate any of the independent claims. The remaining dependent claims that were rejected under § 102 are allowable at least by virtue of their dependency on their respective independent claims.

Claims 5-9, 13, 22-25, 31, 38-40, and 48 were rejected under 25 U.S.C. § 103(a) as being unpatentable over Misra (identified above). Applicant respectfully traverses this rejection for the following reasons.

The identified claims (i.e., claims 5-9, 13, 22-25, 31, 38-40, and 48) are dependent claims. The above-cited passages of Misra do not disclose the subject matter

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of each of these claims at least by virtue of the fact that these passages do not disclose the subject matter of these dependent claims' respective independent claims. Moreover, rejection of the claims under § 103 does not overcome the deficiencies identified above. Since Misra's above-cited passages disclose an entirely different strategy than what is being claimed, the claimed invention cannot be considered an obvious variant of Misra's technique described in the above-cited passages.

Conclusion

The arguments presented above are not exhaustive; Applicant reserves the right to present additional arguments to fortify its position. Further, Applicant reserves the right to challenge the alleged prior art status of one or more documents cited in the Office Action.

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited. The Examiner is urged to contact the undersigned if any issues remain unresolved by this Amendment.

Respectfully Submitted,

Dated: November 30, 2005 By: 

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